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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/783,726

02/14/2001

Mihal Lazaridis

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07/17/2008

RESEARCH IN MOTION

ATTN: GLENDA WOLFE

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EXAMINER

STRANGE, AARON N

ART UNIT

PAPER NUMBER

2153

MAIL DATE

DELIVERY MODE

07/17/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/783,726	<b>Applicant(s)</b> LAZARIDIS ET AL.	
	<b>Examiner</b> AARON STRANGE	<b>Art Unit</b> 2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 102-129 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 102-129 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. In the interest of expedited prosecution, the Examiner would like to recommend conducting an interview prior to filing a response to the present Office action. The Examiner feels that an interview would help foster a mutual understanding of the respective positions of Applicant and the Examiner, and assist in the identification of allowable subject matter and/or issues for appeal. If Applicant agrees that an interview would be beneficial, he/she is encouraged to contact the Examiner to schedule one.

### ***Suspension of Action***

2. Applicant's request for a suspension of action for a period of three months under 37 C.F.R. §1.103 was approved (See PTO-90C mailed 1/24/2008). The suspension period has elapsed, resulting in issuance of the present Office action.

### ***Response to Arguments***

3. It is noted that Applicant has presented no substantive arguments directed to either the provisional double patenting rejections or the rejections set forth under 35 U.S.C. §103(a). It is noted that Applicant expressed an intention to submit a supplemental submission presenting a showing of secondary considerations, but no supplemental submission has yet been received by the Office.

***Response to Amendment***

4. While Applicant has presented no arguments directed to the patentability of the present claims, the independent claims have been amended to require delivery of the copy of the user data item in real time. This feature is taught by AirMobile, which clearly discloses that the messages are "immediately downloaded when they are received" (p. 30). Messages delivered immediately upon receipt are delivered in "real-time".

***Double Patenting***

5. Applicant has failed to adequately traverse the double patenting rejections presented in the Office action of 10/13/2006. Therefore, the rejections have been maintained. In the interest of brevity, they will not be repeated here.

***Specification***

6. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification makes no reference to the term "computer-accessible medium", which appears in claims 122-129. Applicant must amend the specification to provide clear support or antecedent basis for the term, taking care to ensure that no new matter is introduced.

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Art Unit: 2153

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 113-121 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

9. Claims 113-121 recite a system claim comprising a plurality of "means for" performing various functions. The specification of the present application discloses that redirector program performs these functions (Specification, 4-8). Since the redirector program is a software program, the disclosure would have suggested to one of ordinary skill in the art that the claimed means are intended to include-only embodiments. Since the claim is not limited to statutory subject matter, it is non-statutory.

Additionally, it is noted that claims 122-129 contain limitations directed to a "code portion for" performing the same functionality as that claimed in claims 113-121. When considered in combination with the language of claims 113-121 and the content of the specification, these provide further evidence that the claimed means are intended to include software per se.

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 2153

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 102-104, 106-113, 115-122 and 124-129 are rejected under 35 U.S.C. § 103(a) as being unpatentable over AirMobile (Software for Lotus cc:Mail Wireless, Communication Client Guide, Motorola, 1995) and Carthy et al. (MAPI Developers Forum post "MAPI Notification" April 12, 1996; hereinafter Carthy) and Eggleston et al. (U.S. Patent No. 5,764,899, hereinafter "Eggleston").

12. Since Applicant has presented no substantive arguments directed to the rejections presented under 35 U.S.C. § 103(a), the rejections are maintained. Regarding the newly added limitation, AirMobile discloses that the messages are "immediately downloaded when they are received" (p. 30). Messages delivered immediately upon receipt are delivered in "real-time".

13. With regard to claim 102, AirMobile disclosed a method of pushing user data items from a messaging host system ("communication server") in real-time delivery to a wireless mobile data device that is associated with a computer (Le. the mobile device in AirMobile is in and of itself a computer) connected over a network to the messaging host system (p. 9, "Communication Server," p. 10, "User Profile Database," pp. 15-16, wherein mail is received and stored at the communication server, and the mail account is associated with a mobile device according the device ID), the method comprising:

Receiving a notification at a redirector component indicating receipt of a user data item by the messaging host system, where the notification is generated in response to receipt of the user data item at the messaging host system and wherein the user data item is addressed to a data store that is associated with the messaging host system and is viewable via the computer (e.g. AirMobile pushes received messages to the mobile clients and this push algorithm is invoked by some internal notification; see inter alia pgs 30 and 31 "enables messages to be immediately downloaded when they are received");

Processing the user data item at the redirector component to add address information associated with the wireless mobile data device (required for delivery to the mobile client, see pg 31 ¶s 1-3);

Sending the user data item from the redirector component to the wireless mobile data device over a wireless network (the actual push or download of the message to the mobile device pg 31, ¶s 1-3), whereby the user data item is pushed to the wireless mobile data device in real-time delivery (AirMobile discloses that the messages are "immediately downloaded when they are received" (p. 30). Messages delivered immediately upon receipt are delivered in "real-time".)

AirMobile disclosed the invention substantially as claimed, however AirMobile failed to specifically recite 1) that the notification is automatically generated in response to receipt of the user data item and 2) transmitting a copy of the received electronic message.

With regard to point (1), AirMobile failed to specifically recite that the notification is automatically generated in response to receipt of the user data item. AirMobile disclosed a server side push technology (pg 31 ¶¶ 1-3), where the server must internally poll for the arrival on new messages in a user's mailbox. Nonetheless Examiner maintains that such an automatic notification must occur in the system in order for the actual forwarding software to be invoked within the computer system. Furthermore even if one were to argue persuasively that such a notification is not inherent then Examiner maintains that adding a new data item automatic notification feature would have been an obvious modification to AirMobile at the time of Applicant's invention, in view of at least Carthy. In a similar art, Carthy disclosed an e-mail system where the notification of new messages in a user's mailbox is sent automatically, as opposed to polling, using an extended MAPI IMAP!adviseSink notification (See the Carthy post describing "full asynchronous" notification in extended MAPI). Carthy further disclosed that in order to receive these automatic notifications the system must register with a software interface associated with the messaging server (i.e. registering with the ImsgStore to receive adviseSinks). Cathy also disclosed that automatic notification is preferable to polling (see the Cohen post below: "Today I do a polling on each mailbox : I open a connection through MAPI functions, I consult, I notify if new mail, and I close the connection. Then I go to the next mailbox and do the same actions. It's not great ☹. So I'd like to know whether -there- exists another way to notify with MAPI, especially a "fully asynchronous" notification"). Automatic notification is preferable to polling for detecting the arrival of new messages since the detection process is more efficient. For example the system no



Art Unit: 2153

longer has the delay associated with polling each user's mailbox and is instead alerted immediately of the arrival of new messages. Additionally less system resources are consumed since the system no longer has to poll the mailbox of each user in order to detect new messages. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the automatic notification functionally disclosed by Carthy within AirMobile's system, since Carthy disclosed automatic notification is preferable to polling and further since the use of automatic notification is more efficient. Again automatic notification is more efficient since the system is alerted immediately of the arrival of new messages and less system resources are consumed.

With regard to point (2), AirMobile discloses forwarding messages received at the messaging server to the wireless device. However, AirMobile does not explicitly state that the messages forwarded to the wireless mail system are a copy. Nonetheless, most e-mail systems that forward messages actually replicate the messages before forwarding, so that a copy of the message is retained in the initial destination mailbox. Such replication is disclosed by Eggleston. In a similar art, Eggleston teaches a system for forwarding messages from a LAN-based host through a wireless host to a mobile client device, wherein the LAN-based host stores messages, thereby maintaining a replica of the messages, before forwarding them to the client (col. 4, lines 44-51; col. 12, lines 32-39, 59-62, wherein the messages are copied and maintained at a host system, and are also sent to target units). Thus, given the teaching of Eggleston, a person having ordinary skill in the art would have readily recognized the desirability and

Art Unit: 2153

advantages of replicating the messages at the messaging server taught by AirMobile, to preserve received messages in case the client memory fails or the message is lost in transmission. Therefore, it would have been obvious to include the mail replication feature taught by Eggleston in the mail forwarding system taught by AirMobile and Carthy.

14. Claims 113 and 122 are rejected under the same rationale as claim 102, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

15. The rejections of claims 103, 104, 106-112, 115-121 and 124-129, as set forth in the Office action of 10/13/2006 are MAINTAINED. In the interest of brevity, they have not been repeated here.

### ***Conclusion***

16. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. While this would normally result in this Office action being made final in accordance with MPEP § 706.07(b), the Examiner has

Art Unit: 2153

elected to make the present Office action NON-FINAL as a courtesy to Applicant and in an effort to expedite prosecution.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to AARON STRANGE whose telephone number is (571)272-3959. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Glenton B. Burgess/  
Supervisory Patent Examiner, Art Unit 2153

/A. S./  
Examiner, Art Unit 2153